

REMARKS

Applicants respectfully traverse and request reconsideration.

Comments Regarding Advisory Action and Restriction

Applicants respectfully submit that the advisory action mailed August 23, 2007 (“Advisory Action”) completely failed to address Applicants’ arguments as detailed in the response filed August 3, 2007 (“Response”). Instead, it appears that the Advisory Action dismissed the Response by mischaracterizing the arguments presented therein. For instance, the Advisory Action states that “the applicant repeatedly argues different restriction types but did not focus on the main restriction “subcombination usable together”. (Continuation Sheet). Applicants disagree. Applicants’ arguments in the Response repeatedly focused on the proper “Subcombinations Usable Together” restriction type as set forth in MPEP § 806.05(d). (See e.g., Response, pp. 24-28). It is ironic that in the very next paragraph of the Advisory Action, the Examiner goes on to state the proper test as set forth in the Response and in MPEP § 806.05(d). By doing so, the Advisory Action: (1) contracts the logic behind the present restriction requirement and (2) supports Applicants’ above contention that Applicant’s arguments in the Response was both responsive to the previous final Office action and proper in view of the MPEP.

More particularly, Applicants note that the restriction requirement type relied on by the Examiner is the “Subcombinations Usable Together” as set forth in MPEP § 806.05(d). In order to properly restrict claims under this restriction type, where applicant claims **“PLURAL SUBCOMBINATIONS USABLE IN A SINGLE COMBINATION AND CLAIMS A COMBINATION THAT REQUIRES THE PARTICULARS OF AT LEAST ONE OF SAID SUBCOMBINATIONS, BOTH TWO-WAY DISTINCTNESS AND REASONS FOR INSISTING ON RESTRICTION ARE NECESSARY.”** MPEP § 806.05(d) (Emphasis

added). What is flatly improper is the Advisory Action's statement that "Since the restriction is directed to subcombinations usable together, there is no combination involved." (Advisory Action, Continuation Sheet). This statement is a facial contradiction of the MPEP test for restriction under this restriction type because a combination must be involved (i.e., minimally disclosed and/or claimed). Further, Applicants note that there: (1) is no basis provided by the Advisory Action for this statement; and (2) does not appear to be any basis for this statement in law or in the MPEP.

Applicants additionally note that the Advisory Action and the previous final Office action completely failed to address the other part of the test: no reasons for insisting on restriction have been provided. As a matter of fact, Applicants note that the Advisory Action failed to even acknowledge that nearly two pages of the Response was directed to the Examiner's duty to show a serious burden on the Examiner if restriction is not maintained. (*See e.g.*, Response, pp. 22, 23-24).

Accordingly, Applicants submit that the Advisory Action has created and applied a restriction type that has no basis in law or in the MPEP and that the Advisory Action itself cannot support in view of the clear test articulated in § 806.05(d) of the MPEP.

Comments on Claims

Although Applicants maintain that the Advisory Action failed to construe and apply the proper test for restriction, Applicants cancelled claims 32-63 and added new claims 64-94 for the sole purpose of advancing prosecution. Claims 32-63 correspond to the alleged "Invention II" as labeled by the previous final Office action. Claims 64-94 generally correspond to the subject matter previously presented in cancelled claims 1-31 (alleged to constitute "Invention I"), respectfully, and also contain modifications made thereto. Applicants submit that it has a right to

resubmit these claims as new claims 64-94 for at least the reason that it reserved such right in the amendment and response filed May 16, 2007 when it cancelled claims 1-31 without prejudice and reserved such right to reintroduce the cancelled subject matter. To assist the Examiner in understanding the relationship between claims 64-94 and cancelled claims 1-31, Applicants turn the Examiner's attention to the Appendix that shows cancelled claims 1-31 with modifications made thereto. The result of modifying cancelled claims 1-31 in the manner shown is claims 64-94 presented above for examination. New claims 95-105 have been added. No new matter has been entered.

As to the outstanding rejection made in the non-final Office action mailed January 16, 2007, Applicants note that Prince does not appear to teach, suggest or even contemplate the claimed subject matter. Specifically and with respect to claim 64, Prince does not appear to teach or suggest:

receiving, by a third entity, a first set of encoded e-mail addresses from a first entity ...;
compiling, by said third entity, a second set of encoded e-mail addresses ...; and
removing, by said third entity, from said first set of encoded e-mail addresses, each encoded e-mail address that is in said second set of encoded e-mail addresses, thereby yielding a third set of encoded e-mail addresses,
wherein a second entity is a source of said e-mail messages.
(Emphasis added).

In contrast, Applicants note that, at best, Prince appears to teach that Applicants' first and second entities are one-and-the-same entity in the Client (*See e.g.*, Prince, ¶ 39). Because Prince does not appear to teach each and every claim limitation of claim 64, specifically those highlighted above using underlined font, Claim 64 appears to be in proper condition for allowance.

Independent claims 70, 74, 78, 81, 84, 86, 87 and 89 contain the same or similar limitations as claim 64 and are therefore believed to be allowable for at least the same reasons as

claim 64. Dependent claims 65-69, 71-73, 75-77, 79-80, 82-83, 85, 88, 90-105 are each dependent upon allowable base claims. In addition to containing additional novel, non-obvious and patentable subject matter, each of these claims is believed to be allowable for at least the same reasons as their respective independent base claim.

Applicants respectfully submit that the claims are in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the below listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Respectfully submitted,

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By: Robert S. Beiser
Robert S. Beiser
Registration No. 28,687

Vedder, Price, Kaufman & Kammholz, P.C.
222 North LaSalle Street, Suite 2600
Chicago, Illinois 60601
phone: (312) 609-7848
fax: (312) 609-5005